UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,700	12/21/2001	Richard Hatch	1076.41036X00	6915

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EXAMINER
DEAN, RAYMOND S

ART UNIT	PAPER NUMBER
2684	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/023,700	HATCH ET AL.
	Examiner	**Art Unit**	
	Raymond S Dean	2684	*I*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 October 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>3, 11, and 13 - 15</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>3, 11, 13 - 15</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>22 October 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Examiner acknowledges the submission of amended drawings to reflect "Prior Art" therefore the objection to the drawings is withdrawn.

2.   Applicant's arguments filed October 22, 2004 have been fully considered but they are not persuasive.

Examiner respectfully disagrees with Applicants' assertion that Schroeder does not teach monitoring the frequency selection of words used from a dictionary and providing an output used to modify the order of the predicted words represented in respect of a given text entry. The candidate words that are displayed are determined by a statistical analysis, which means that there is a counting of the words most frequently selected. The list of candidate words will change based on the text that is entered by the user thus there will be a different set of words with a different order that make up said candidate list (See Figure 4, Column 6 lines 17 – 41, Column 7 lines 37 – 39).

Examiner respectfully disagrees with Applicants' assertion on Page 12, 3rd Paragraph of the Remarks "Regarding Claims 3, 11, and 13 Applicants submit that none of the cited references....". Sharma teaches a mobile telecommunications device comprising a memory for storing a plurality of user selectable items (Figure 3, Section 0021 lines 8 – 11, the user selectable items are the contacts in the phone book) and a controller operable to order said items according to the frequency of selection of each

item (Section 0019, Section 0021 lines 4 – 7, the software is the control program which

resides on the controller). Schroeder teaches wherein the plurality of user selectable

items is a dictionary of words (Column 6 lines 30 – 31), predicting and selecting a word

stored in the dictionary in response to a text message entry (Figure 4, Column 6 lines

17 – 41), initially predicting and selecting the word most frequently selected by the user

when more than one word fits a prediction (Figure 4, Column 6 lines 17 – 41). It would

have been obvious to one of ordinary skill in the art at the time the invention was made

to use the prediction and selection method taught above by Schroeder in the wireless

phone of Sharma for the purpose of providing a hand held wireless phone that offers

user friendly features that are easy to use despite the space limitations of the keyboard

as taught by Schroeder.

Examiner respectfully disagrees with Applicants' assertion on Page 13, 2nd

Paragraph of the Remarks "For example, Applicants submit that none of ...". Sharma

further teaches a computer readable medium (Section 0021 lines 8 – 10, the memory

that stores the control program is the computer readable medium).

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Schroeder et al. (5,797,098).

Regarding Claim 15, Schroeder teaches a predictive text-input means for text message entry on a mobile communications device (Figure 4, Column 6 lines 17 – 41), the predictive text input means presents, in response to a given text entry, one or more word predictions from a dictionary of words used by the predictive text input means (Figure 4, Column 6 lines 17 – 41), the predictive text input means comprising a counter that monitors the frequency of selections of words used from the dictionary (Column 7 lines 37 – 47, the candidate words that are displayed are determined by a statistical analysis, which means that there is a counting of the words most frequently selected) and provides an output based on the monitored frequency of selection, which output is used to modify the order of the predicted words presented in respect of the given text-entry (Column 7 lines 37 – 47, the most frequently selected words will be displayed, the list of candidate words will change based on the text that is entered by the user thus there will be a different set of words with a different order that make up said candidate list).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 3, 11, and 13 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharma (US 2002/0151334 A1) in view of Schroeder et al. (5,797,098).

Regarding Claim 3, Sharma teaches a mobile telecommunications device comprising a memory for storing a plurality of user selectable items (Figure 3, Section 0021 lines 8 – 11, the user selectable items are the contacts in the phone book) and a controller operable to order said items according to the frequency of selection of each item (Section 0019, Section 0021 lines 4 – 7, the software is the control program which resides on the controller).

Sharma does not teach wherein the plurality of user selectable items is a dictionary of words, predicting and selecting a word stored in the dictionary in response to a text message entry, initially predicting and selecting the word most frequently selected by the user when more than one word fits a prediction.

Schroeder teaches wherein the plurality of user selectable items is a dictionary of words (Column 6 lines 30 – 31), predicting and selecting a word stored in the dictionary in response to a text message entry (Figure 4, Column 6 lines 17 – 41), initially predicting and selecting the word most frequently selected by the user when more than one word fits a prediction (Figure 4, Column 6 lines 17 – 41).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to use the prediction and selection method taught above by

Schroeder in the wireless phone of Sharma for the purpose of providing a hand held

wireless phone that offers user friendly features that are easy to use despite the space

limitations of said keyboard as taught by Schroeder.

Regarding Claim 11, Sharma teaches a method of handling a plurality of user

selectable items stored in a memory of a mobile telecommunications device (Figure 3,

Section 0021 lines 8 – 11, the user selectable items are the contacts in the phone

book), the method including the step of ordering items according to the frequency of

selection of each item (Section 0019).

Sharma does not teach wherein the plurality of user selectable items is a

dictionary of words, predicting and selecting a word stored in the dictionary in response

to a text message entry, predicting and selecting the word most frequently selected by

the user when more than one word fits a prediction.

Schroeder teaches wherein the plurality of user selectable items is a dictionary of

words (Column 6 lines 30 – 31), predicting and selecting a word stored in the dictionary

in response to a text message entry (Figure 4, Column 6 lines 17 – 41), predicting and

selecting the word most frequently selected by the user when more than one word fits a

prediction (Figure 4, Column 6 lines 17 – 41).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to use the prediction and selection method taught above by

Schroeder in the wireless phone of Sharma for the purpose of providing a hand held

wireless phone that offers user friendly features that are easy to use despite the space limitations of said keyboard as taught by Schroeder.

Regarding Claim 13, Sharma teaches a program run on a computer (Section 0021 lines 4 – 7, the processor is the computer).

Sharma does not teach a method of predicting and selecting a word from a dictionary of words stored in a memory in response to a text message entry by the user and initially predicting and selecting the word most frequently selected by the user when more than one word fits a prediction.

Schroeder teaches predicting and selecting a word form a dictionary of words stored in a memory in response to a text message entry (Figure 4, Column 6 lines 17 – 41), initially predicting and selecting the word most frequently selected by the user when more than one word fits a prediction (Figure 4, Column 6 lines 17 – 41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the prediction and selection method taught above by Schroeder in the wireless phone of Sharma for the purpose of providing a hand held wireless phone that offers user friendly features that are easy to use despite the space limitations of said keyboard as taught by Schroeder.

Regarding Claim 14, Sharma in view of Schroeder teaches all of the claimed limitations recited in Claim 13. Sharma further teaches a computer readable medium (Section 0021 lines 8 – 10, the memory that stores the control program is the computer readable medium).

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
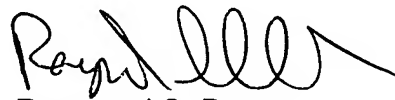
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond S Dean whose telephone number is 703-305-8998. The examiner can normally be reached on 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay A Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Raymond S. Dean
March 23, 2005

NICK CORSARO
PRIMARY EXAMINER